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Paper No.

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**COPY MAILED**

**OCT 25 2004**

In re Application of	:	<b>OFFICE OF PETITIONS</b>
Timothy Breeden and Doug Dew	:	
Application No. 10/733,989	:	DECISION REFUSING
Filed: December 11, 2003	:	STATUS UNDER
Title of Invention:	:	37 CFR 1.47
SYSTEM AND METHOD FOR SOFTWARE	:	
APPLICATION DEVELOPMENT IN A PORTAL	:	
ENVIRONMENT	:	

This is in response to a petition under 37 CFR 1.47(a), filed September 30, 2004, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s).

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on December 11, 2003, without a fully executed oath or declaration. The Office mailed a Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice"), on April 27, 2004, requiring *inter alia*, an executed oath or declaration.

In response to the Notice, Applicant files the instant petition under 37 CFR 1.47(a), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventors.

In support of the petition the Applicant provides a Declaration Under 37 CFR §1.47 on Behalf of Signing Inventors in Support of Petition to Accept Declaration in Response to a Missing Parts Without the Signature of a Joint Inventor, executed by Karl F. Kenna, wherein Mr. Kenna declares that formal papers, "namely a Declaration for Patent Application and an Assignment" were sent to the nonsigning inventor via email and via Federal Express, and have not been returned. Kenna Declaration at p.2.

#### Applicable Law

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) and (2).

As to item (1), where it is alleged that an applicant refuses to join an application, the applicant must establish that the nonsigning inventor was presented with the application for signature. The Manual of Patent Examining Procedure ("MPEP") states that

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

MPEP 409.03(d).

As to item (1), applicant failed to show or provide proof that the inventor refused to sign the declaration. Before an inventor can refuse to sign an oath or declaration, he must have

been presented with a copy of the application papers (specification, claims and drawings). See MPEP 409.03(d).

Applicant must present a copy of the application papers to the inventor.

As to item (2), Applicant has failed to provide an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116. A review of the oath or declaration filed with the instant petition reveals that the citizenship of inventor Dew is missing from the declaration. An oath or declaration that includes the inventor's citizenship is required.


Further correspondence with respect to this matter should be addressed as follows:

By mail:           Mail Stop PETITIONS  
                    Commissioner for Patents  
                    PO Box 1450  
                    Alexandria, VA 22313-1450

By FAX:           (571) 273-0025  
                    Attn: Office of Petitions

By hand:           Customer Window Located at:  
                    U.S. Patent & Trademark Office  
                    220 20<sup>th</sup> Street S.  
                    Customer Window, Mail Stop PETITIONS  
                    Crystal Plaza Two, Lobby Room 1B03  
                    Arlington, VA 22202

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

  
Derek L. Woods  
Attorney Advisor  
Office of Petitions